

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10013644-1

IN THE
UNITED PATENT AND TRADEMARK OFFICE

Inventors: Casati, et al. Confirmation No.: 4968
Application No.: 10/032,363 Examiner: Boyce, Andre D.
Filing Date: 12/21/2001 Group Art Unit: 3623
TITLE: METHOD AND SYSTEM FOR PERFORMING A CONTEXT-DEPENDENT SERVICE

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO DIRECTOR UNDER 37 CFR § 1.181 - PETITION TO WITHDRAW HOLDING
OF ABANDONMENT

PETITION

1. Applicant petitions that the notice mailed by the office on 8/9/2010 be withdrawn.
2. Petition states that the Examiner incorrectly applied the guidelines of MPEP § 1214.01(1)(I) in refusing to enter the claim amendments submitted on May 17, 2010, resulting in the abandonment of the instant application or, in the alternative, the Examiner incorrectly applied 37 CFR § 41.50(b)(1) in refusing to allow the Applicants to correct the error under 37 CFR § 1.135(c).

SUBMISSIONS

3. Submitted herewith is:
 - ☒ Statement of Facts/Point to be Reviewed/Requested Action in Support of a Petition to the Director under 37 CFR § 1.181 - Petition to Withdraw Holding of Abandonment.
 - ☒ Exhibit A: Notice of Improper Amendment
 - ☒ Exhibit B: Decision on Appeal
 - ☒ Exhibit C: Notice of Abandonment
 - ☒ Exhibit D: Examiner Interview Summary

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally, please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,
Casati, et al.
By: /Matthew J. Blecher/
Matthew J. Blecher
Attorney/Agent for Applicants
Reg. No.: 46,558
Date: 09/29/2010
Telephone: 408-377-0500

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Casati, et al.)	Examiner: Boyce, Andre D.
)	
Serial No.: 10/032,363)	Art Unit: 3623
)	
Filed: December 21, 2001)	Confirmation No.: 4968
)	
For: METHOD AND SYSTEM FOR)	
PERFORMING A CONTEXT-)	
DEPENDENT SERVICE)	
)	

Mail Stop Petition
Commissioner of Patents
Alexandria, VA 22313-1450

PETITION TO THE DIRECTOR UNDER 37 CFR § 1.181 – PETITION TO
WITHDRAW HOLDING OF ABANDONMENT – STATEMENT OF
FACTS/POINT TO BE REVIEWED/REQUESTED ACTION

Dear Sir:

In response to the Notice of Abandonment with a notification date of August 9, 2010, and the Notice of Improper Amendment with a notification date of July 30, 2010, Applicants respectfully request consideration of the following Statement of Facts, Point to be Reviewed, and Requested Action in support of the Petition to the Director under 37 CFR § 1.181 (Petition to Withdraw Holding of Abandonment) filed herewith.

STATEMENT OF FACTS

1. On March 12, 2010, the Board of Patent Appeals and Interferences (hereinafter referred to as the “BPAI”) issued a Decision on Appeal for Appeal 2009-006257 pertaining to Application No. 10/032,363, with a notification date of March 16, 2010.

2. The Decision on Appeal included a New Ground of Rejection, pursuant to 37 CFR § 41.50(b), on Claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

3. 37 CFR § 41.50(b)(1) recites:

Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

4. The Manual of Patent Examining Procedure (hereinafter referred to as the “MPEP”) recites that

37 CFR 41.50(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits “an appropriate amendment” of the claims rejected by the Board, “or new evidence relating to the claims so rejected, or both.” An amendment is “appropriate” under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board.

...

The new ground of rejection raised by the Board does not reopen * prosecution except as to that subject matter to which the new

rejection was applied. If the Board's decision in which the rejection under 37 CFR *41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR *41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR *41.50(b) rejection. If the application becomes allowed, the application should not be returned to the Board.

(emphasis added; MPEP § 1214.01(I)).

5. In response to the Decision on Appeal including a New Ground of Rejection, and pursuant to 37 CFR § 41.50(b)(1), Applicants Reopened Prosecution by submitting an Amendment and Response to the Decision on Appeal addressing the New Ground of Rejection on May 17, 2010. Applicants note that other claim amendments beyond those directed toward the New Ground of Rejection were also submitted at this time. These other amendments to independent Claims 1, 10 and 17 were made in response to the statement “[w]e note that claim 1 is silent as to what the context information is being detected from, and does not preclude the claimed ‘detecting’ from being detecting the presence of the context information in a set of data” (Decision on Appeal; page 6, lines 18-21) from the Decision on Appeal.

6. A Notice of Improper Amendment for Application No. 10/023,363 was mailed by Examiner Boyce on July 30, 2010. In the Notice of Improper Amendment, Examiner Boyce indicated that “[t]he amendment filed 5/17/10 after a decision by the Board of Patent Appeals and Interferences is not

entered because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Board under 37 CFR 41.50(c)" (Notice of Improper Amendment; page 2, lines 3-6).

7. A Notice of Abandonment for Application No. 10/023,363 was mailed by Examiner Boyce on August 9, 2010. In the Notice of Abandonment, Examiner Boyce restated that the "amendment filed 5/17/10 was not entered" (Notice of Abandonment; item 7).

8. On Thursday, August 26, 2010, Matthew J. Blecher, representative for Applicants, participated in a telephonic Examiner interview with Examiner Boyce to discuss the Notice of Abandonment. Mr. Blecher requested clarification as to why the Notice of Abandonment was mailed, and suggested that Examiner Boyce misinterpreted MPEP § 1214.01(I) in refusing to enter the amendments submitted on May 17, 2010. Mr. Blecher submitted that since the new Ground of Rejection was addressed by amendments, that refusal to enter the appropriate amendments is improper and without precedent. Mr. Blecher submitted that the proper course of action would have been to enter the amendments, and prepare a Final Office Action addressing the New Ground of Rejection with the option of being silent to the additional amendments. Examiner Boyce acknowledged that the Amendment and Response appeared *bona fide*, and acknowledged that the New Ground of Rejection under 35 U.S.C. § 101 was adequately addressed, but was not persuaded in his refusal to enter the amendments was improper.

9. During the Thursday, August 26, 2010, telephonic Examiner interview, Mr. Blecher also submitted that, at a minimum, since the Amendment and Response was *bona fide* as acknowledged by Examiner Boyce, the Applicants should have been given a one-month time period to correct the reply in accordance with 37 CFR 1.135(c). Examiner Boyce responded that it was his understanding that the period for response that was controlling in this instance was the non-extendible two-month response period beginning with the notification date of the Decision on Appeal. Mr. Blecher countered by stating that 37 CFR § 41.50(b)(1) states that the submission of an amendment results in the proceeding being “remanded to the examiner.” Therefore, once the Amendment and Response were timely submitted and prosecution was reopened by remanding the proceeding to the Examiner, the period for response was no longer controlled by the Decision on Appeal, but rather was restarted pending the next Office Action. Examiner Boyce acknowledged that he was unsure as to which course of action was correct, but would not change his decision at this point in time.

POINT TO BE REVIEWED/REMARKS

10. Applicants respectfully submit that Examiner Boyce improperly issued a Notice of Abandonment for the instant application, and request reversal of the holding of abandonment.

11. Applicants respectfully submit that Examiner Boyce’s refusal to enter the amendments submitted on May 17, 2010, was improper. As presented above, the MPEP recites that “[a]n amendment is ‘appropriate’ under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid

the art or reasons adduced by the Board” (MPEP § 1214.01(I)). Applicants respectfully submit that the amendments submitted on May 17, 2010, satisfy this requirement. Moreover, Applicants note that the MPEP further recites that “[p]rosecution before the examiner of the 37 CFR *>41.50(b)< rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR *>41.50(b)< rejection” (emphasis added; MPEP § 1214.01(I)). Accordingly, Applicants respectfully submit that the amendments submitted responsive to the Decision on Appeal were permissible and appropriate under 37 CFR § 41.50(b).

12. Moreover, Applicants respectfully submit that Examiner Boyce’s failure to provide Applicants with an opportunity to correct the amendment according to Examiner Boyce’s interpretation of MPEP § 1214.01(I) was improper since prosecution had been reopened and the Amendment and Response was *bona fide*. As presented above, 37 CFR § 41.50(b)(1) states that the submission of an amendment results in the proceeding being “remanded to the examiner.” Therefore, once the Amendment and Response were timely submitted and prosecution was reopened by remanding the proceeding to the Examiner, the period for response was no longer controlled by the Decision on Appeal, but rather was restarted pending the next Office Action. Accordingly, Applicants respectfully submit that the Applicants should be afforded an opportunity to correct the amendments according to Examiner Boyce’s interpretation of MPEP § 1214.01(I).

13. Applicants submit that the plain language of MPEP § 1214.01(I) recites that “[a]n amendment is ‘appropriate’ under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board” (MPEP § 1214.01(I)). Applicants submit that the Amendment and Response submitted on May 17, 2010, satisfies this requirement. Moreover, Applicants respectfully submit that the plain language of 37 CFR § 41.50(b)(1) states that the submission of an amendment results in the proceeding being “remanded to the examiner.” Applicants submit that the Applicants must be afforded an opportunity to correct any errors as interpreted by the Examiner. Specifically, Applicants respectfully submit that Examiner Boyce’s interpretation of MPEP § 1214.01(I) and 37 CFR § 41.50(b)(1) is in direct opposition to the just administration of U.S. Patent Laws and Rules. Moreover, by applying a different standard to the instant application than is required by U.S. patent policy and denying the Applicants the ability to obtain a patent on non-rejected subject matter by improperly abandoning the instant application, the Applicants have been denied fair administration of the U.S. patent system.

REQUESTED ACTION –
WITHDRAW HOLDING OF ABANDONMENT

14. Applicants respectfully submit that Examiner Boyce’s refusal to enter the amendments submitted on May 17, 2010, ultimately resulting in the abandonment of the instant application, was improper and not supported by precedent. Therefore, Applicants respectfully request that the Notice of Abandonment be withdrawn and that Examiner Boyce be directed to enter the amendments submitted on May 17, 2010.

15. In the alternative, Applicants respectfully submit that Examiner Boyce's refusal to allow the Applicants an opportunity to correct the amendments according to Examiner Boyce's interpretation of MPEP § 1214.01(I) was improper, as prosecution had been reopened and remanded to Examiner Boyce. Therefore, Applicants respectfully request that the Notice of Abandonment be withdrawn and that Examiner Boyce be directed to grant the Applicants a one-month time limit to correct the amendments in accordance with 37 CFR § 1.135(c).

CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration and reversal of the holding of abandonment. Applicants further request that the Examiner be directed to proceed in accordance with MPEP § 1214.01(I) by entering the previously submitted amendments or, in the alternative, be directed to allow the Applicants an opportunity to correct the Examiner's stated error in the previously submitted amendments in accordance with 37 CFR § 1.135(c).

The Office of Petitions is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER BLECHER LLP

Date: 09/29/2010

/Matthew J. Blecher/
Matthew J. Blecher
Registration No. 46,558

Address:

Westridge Business Park
123 Westridge Drive
Watsonville, California 95076 USA

Telephone:

(408) 377-0500 Voice
(408) 309-8069 Direct/Cell



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,363	12/21/2001	Fabio Casati	10013644-1	4968
22879 7590 07/30/2010 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER BOYCE, ANDRE D	
			ART UNIT 3623	PAPER NUMBER
			NOTIFICATION DATE 07/30/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

DETAILED ACTION

Notice of Improper Amendment

1. The amendment filed 5/17/10 after a decision by the Board of Patent Appeals and Interferences is not entered because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Board under 37 CFR 41.50(c).

Specifically, independent claims 1, 10 and 17 have been amended to include “and wherein said automatically detected context information comprises up-to-date present user location.” Although the decision by the Board of Patent Appeals and Interferences does include, pursuant to 37 C.F.R. § 41.50(b) (2009), a new ground of rejection on claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, the new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR § 41.50(b) was made includes an affirmance of the examiner's rejection, **the basis of the affirmed rejection is not open to further prosecution**, as discussed in the MPEP § 1214.01 I.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/
Primary Examiner, Art Unit 3623
July 27, 2010



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RECEIVED*By IPA at 9:57 pm, Mar 17, 2010*

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,363	12/21/2001	Fabio Casati	10013644-1	4968
<div>22879 7590 03/16/2010 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528</div>				
			EXAMINER BOYCE, ANDRE D	
			ART UNIT 3623	PAPER NUMBER
			NOTIFICATION DATE 03/16/2010 ✓	DELIVERY MODE ELECTRONIC

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The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FABIO CASATI and
MING-CHIEN SHAN

Appeal 2009-006257
Application 10/032,363
Technology Center 3600

Decided: March 12, 2010

Before HUBERT C. LORIN, FRANCISCO C. PRATS, and
BIBHU MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Fabio Casati et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-23. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM and enter a new grounds of rejection pursuant to 37 C.F.R. 41.50(b).¹

THE INVENTION

This invention is a method and system for performing a c-service which is tailored to the specific user and their location. Specification 4:2-6.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for performing a context-dependent service comprising:
 - executing a composite service;
 - utilizing a context repository to store context information for a user, wherein said context information is automatically detected without requiring user interaction and wherein said context information is based on a present user location;
 - accessing context information; and
 - automatically incorporating said context

¹ Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Mar. 4, 2008) and the Examiner's Answer ("Answer," mailed May 28, 2008).

information with said composite service.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ramanathan	US 6,182,136 B1	Jan. 30, 2001
Stewart	US 2002/0161688 A1	Oct. 31, 2002

Fabio Casati, Ski Ilnicki, Li-Jie Jin, Vasudev Krishnamoorthy, Ming-Chien Shan, *eFlow: a Platform for Developing and Managing Composite e-Services*, HP Laboratories, March 2000. [Hereinafter, Casati.]

The following rejections are before us for review:

1. Claims 1-5, 7, 8, 10-14, 16-21, and 23 are rejected under 35 U.S.C. §102(b) as being anticipated by Casati.
2. Claims 6, 15, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Casati and Stewart.
3. Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Casati and Ramanathan.

ARGUMENT

The Appellants and the Examiner dispute whether the paragraph labeled 27, on page 345 of Casati describes that the context information is automatically detected without requiring user interaction. *See* Br. 9-11 and Answer 8. The Examiner equates this claim limitation to Casati's "dynamic process evolution, wherein for example, the user has booked a flight with an air carrier hit by a strike and eFlow automatically detects the airline strike, i.e., context information, and defines a new process." Answer 4.

The Appellants respond that Casati does not teach automatically detecting the strike itself. Br. 10-11.

ISSUE

The issue is whether claims 1-5, 7, 8, 10-14, 16-21, and 23 under 35 U.S.C. §102(b) are anticipated by Casati. Specifically, the issue is whether Casati describes that the context information is automatically detected without requiring user interaction. The rejections of claims 6, 9, 15 and 22 will also turn on this issue.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Casati describes a composite service called *eMove* that supports customers in relocating. Casati pg. 341, par. 4.
2. On page 345, in paragraph 27, Casati states:

Dynamic process evolution: eFlow allows service designers to modify service process definitions and to apply the changes to a subset of (or to all) the running instances of that service. In addition, the service designer may specify that newly started services should follow the new definition. For instance, consider the situation in which a strike hit a big airline company and is assumed to last for a long period: clearly, it is not practically feasible to separately modify each process instance; instead, with *eFlow*, the service designer can define a new process and specify that all running instances with a given property (in this case, all instances in which the customer has booked a flight with the

air carrier hit by the strike) should be migrated to the new version.

The definition of service instances that need to be migrated is performed through a very simple migration language, consisting of a set of rules of the form IF <condition> THEN MIGRATE TO <version>. The condition is a predicate over service process data and service process execution state that identifies a subset of the running instances, while <version> denotes the process definition version to which instances should be migrated. The set of rules must define a partitioning over the set of active instances, so that each instance is migrated to one version at most. An example of migration rule is: IF (selectedAirlines = "Flying High" and travelStatuts = "booked") THEN MIGRATE TO "A.00.02." Casati 345.

PRINCIPLES OF LAW

Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences

between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also* *KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-5, 7, 8, 10-14, 16-21, and 23 under §102(b) as being anticipated by Casati.

The Appellants argue claims 1-5, 7, 8, 10-14, 16-21, and 23 as a group. Br. 9-11. We select claim 1 as the representative claim for this group, and the remaining claims 2-5, 7, 8, 10-14, 16-21, and 23 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

Claim 1 recites “wherein said context information is automatically detected without requiring user interaction.” We note that claim 1 is silent as to what the context information is being detected from, and does not preclude the claimed “detecting” from being detecting the presence of the context information in a set of data.

Casati’s describes an example where an airline, named “FlyHigh,” is experiencing a strike and processes need to be modified so that flights are rebooked. *See* FF 2. The name “FlyHigh” can be considered the claimed user context information, since it is the airline that pertains to the user. Casati “detects” the presence of the name “FlyHigh” in the running instances

using a migration rule; for example, if “selectedAirlines” in the data equals “FlyHigh.” *Id.* The migration rule is part of a newly defined process (*id.*), which can be considered to be performing the detection automatically without requiring user interaction.

As Casati states, the service designer does not manually go through all of the running instances to find the instances where “selectedAirlines” equals “FlyHigh,” as this would not be “practically feasible.” *Id.* Rather, the migration rule put into place by the designer automatically detects the user’s airline information. Thus, the detection is automatic, by way of the migration rule, despite the fact that the service designer set the migration rule.

We find that the Appellants have not overcome the prima facie case of anticipation. Accordingly, we sustain the rejection of claims 1-5, 7, 8, 10-14, 16-21, and 23 under §102(b) as being anticipated by Casati.

The rejection of claims 6, 15, and 22 under §103(a) as being unpatentable over Casati and Stewart.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 6, 15, and 22 as being unpatentable over Casati and Stewart since the Appellants have not made any arguments beyond those previously discussed with regard to the Casati reference, thereby allowing claims 6, 15, and 22 to stand or fall with their parent claim. *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

The rejection of claim 9 under §103(a) as being unpatentable over Casati and Ramanathan.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 9 as being unpatentable over Casati and Ramanathan since the Appellants have not made any arguments beyond those previously discussed with regard to the Casati reference, thereby allowing claim 9 to stand or fall with its parent claim. *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b) (2009), we enter a new ground of rejection on claims 17-23. Claims 17-23 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Taking claim 17 as representative, claim 17 recites “[a] computer-usable medium having a computer-readable program code embodied therein.” We note that the Specification is silent as the meaning of “computer-usable medium.” Giving claim 17 the broadest reasonable construction, we find that claim 17 encompasses forms of the computer program code being embodied on transitory propagating signals *per se*.² A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. §101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

² *See* U.S. Patent & Trademark Office, Subject Matter Eligibility of Computer Readable Media, Jan. 26, 2010, available at http://www.uspto.gov/patents/law/notices/101_crm_20100127.pdf.

Accordingly, we reject claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

CONCLUSIONS OF LAW

We conclude that the Appellants have not over come the prima facie showing of anticipation in the rejections of claims 1-5, 7, 8, 10-14, 16-21, and 23 under 35 U.S.C. §102(b) as being anticipated by Casati and the Appellants have not over come the prima facie showing of obviousness in the rejection of:

claims 6, 15, and 22 under 35 U.S.C. §103(a) as unpatentable over Casati and Stewart; and

claim 9 under 35 U.S.C. §103(a) as unpatentable over Casati and Ramanathan.

We enter a new ground of rejection on claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The decision of the Examiner to reject claims 1-23 is affirmed. We enter a new ground of rejection on claims 17-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Appeal 2009-006257
Application 10/032,363

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

AFFIRMED; 37 C.F.R. § 41.50(b)

mev

HEWLETTE-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
3404 E. HARMONY ROAD
MAIL STOP 35
FORT COLLINS, CO 80528



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,363	12/21/2001	Fabio Casati	10013644-1	4968
22879 7590 08/09/2010 HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER BOYCE, ANDRE D	
			ART UNIT 3623	PAPER NUMBER
			NOTIFICATION DATE 08/09/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

Notice of Abandonment	Application No.	Applicant(s)	
	10/032,363	CASATI ET AL.	
	Examiner	Art Unit	
	Andre Boyce	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☒ The decision by the Board of Patent Appeals and Interference rendered on 16 March 2010 and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Moreover, as discussed in the Miscellaneous Communication mailed 7/30/10, the amendment filed 5/17/10 was not entered.

/Andre Boyce/
Primary Examiner, Art Unit 3623

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Electronic Acknowledgement Receipt

EFS ID:	8516929
Application Number:	10032363
International Application Number:	
Confirmation Number:	4968
Title of Invention:	Method and system for performing a context-dependent service
First Named Inventor/Applicant Name:	Fabio Casati
Customer Number:	22879
Filer:	Matthew J. Blecher/Ilene Fish
Filer Authorized By:	Matthew J. Blecher
Attorney Docket Number:	10013644-1
Receipt Date:	28-SEP-2010
Filing Date:	21-DEC-2001
Time Stamp:	16:32:01
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		10013644-1-IntSummary.pdf	90486 7a11fcd2f9922b54446ddc022e96f25e906b7fc7	yes	5

	Multipart Description/PDF files in .zip description		
	Document Description	Start	End
	Miscellaneous Incoming Letter	1	1
	Applicant summary of interview with examiner	2	5
Warnings:			
Information:			
Total Files Size (in bytes):		90486	
<p>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</p> <p><u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>			

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
Fort Collins, Colorado 80528

PATENT APPLICATION

ATTORNEY DOCKET NO. 10013644-1

Inventor(s): Fabio CASATI et al.

Confirmation No.: 4968

Application No.: 10/032,363

Examiner: Boyce, Andre D.

Filing Date: 12/21/2001

Group Art Unit: 3623

Title: METHOD AND SYSTEM FOR PERFORMING A CONTEXT-DEPENDENT SERVICE

Mail Stop Amendment
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☐ No additional fee
☒ Other Examiner Interview Summary Fee \$ 0

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$52	\$
INDEP. CLAIMS		MINUS		=	X \$220	\$
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$390	\$ 0
EXTENSION FEE	<input type="checkbox"/> 1st Month \$130	<input type="checkbox"/> 2nd Month \$490	<input type="checkbox"/> 3rd Month \$1110	<input type="checkbox"/> 4th Month \$1730		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

Respectfully submitted,
Fabio CASATI et al.

By: /Matthew J. Blecher/

Matthew J. Blecher
Attorney/Agent for Applicant(s)

Reg No. : 46,558

Date : 09/28/2010

Telephone : 408-377-0500

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Casati, et al.)	Examiner: Boyce, Andre D.
)	
Serial No.: 10/032,363)	Art Unit: 3623
)	
Filed: December 21, 2001)	Confirmation No.: 4968
)	
For: METHOD AND SYSTEM FOR)	
PERFORMING A CONTEXT-)	
DEPENDENT SERVICE)	
)	

Commissioner of Patents
Alexandria, VA 22313-1450

EXAMINER INTERVIEW SUMMARY

On Thursday, August 26, 2010, Matthew J. Blecher, representative for Applicants, participated in a telephonic Examiner interview with Examiner Boyce to discuss the Notice of Abandonment. Mr. Blecher requested clarification as to why the Notice of Abandonment was mailed, and suggested that Examiner Boyce misinterpreted MPEP § 1214.01(I) in refusing to enter the amendments submitted on May 17, 2010. Mr. Blecher submitted that since the new Ground of Rejection was addressed by amendments, that refusal to enter the appropriate amendments is improper and without precedent. Mr. Blecher submitted that the proper course of action would have been to enter the amendments, and prepare a Final Office Action addressing the New Ground of Rejection with the option of being silent to the additional amendments.

Examiner Boyce indicated that the amendments were not entered because additional amendments beyond those necessary to overcome the New

Ground of Rejection were submitted. Mr. Blecher acknowledged that these amendments were made in response to a statement in the Decision on Appeal that “[w]e note that claim 1 is silent as to what the context information is being detected from, and does not preclude the claimed ‘detecting’ from being detecting the presence of the context information in a set of data” (Decision on Appeal; page 6, lines 18-21). Examiner Boyce acknowledged that the Amendment and Response appeared *bona fide*, and acknowledged that the New Ground of Rejection under 35 U.S.C. § 101 was adequately addressed, but was not persuaded in his refusal to enter the amendments was improper.

During the Thursday, August 26, 2010, telephonic Examiner interview, Mr. Blecher also submitted that, at a minimum, since the Amendment and Response was *bona fide* as acknowledged by Examiner Boyce, the Applicants should have been given a one-month time period to correct the reply in accordance with 37 CFR 1.135(c). Examiner Boyce responded that it was his understanding that the period for response that was controlling in this instance was the non-extendible two-month response period beginning with the notification date of the Decision on Appeal. Mr. Blecher countered by stating that 37 CFR § 41.50(b)(1) states that the submission of an amendment results in the proceeding being “remanded to the examiner.” Therefore, once the Amendment and Response were timely submitted and prosecution was reopened by remanding the proceeding to the Examiner, the period for response was no longer controlled by the Decision on Appeal, but rather was restarted pending the next Office Action. Examiner Boyce acknowledged that he was unsure as to which course of action was correct, but would not change his decision at this point in time.

Applicants wish to thank Examiner Boyce for taking the time to participate in the Examiner interview.

CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration and reversal of the holding of abandonment. Applicants further request Examiner Boyce to proceed in accordance with MPEP § 1214.01(I) by entering the previously submitted amendments or, in the alternative, allow the Applicants an opportunity to correct the Examiner's stated error in the previously submitted amendments in accordance with 37 CFR § 1.135(c).

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER BLECHER LLP

Date: 09/28/2010

/Matthew J. Blecher/

Matthew J. Blecher
Registration No. 46,558

Address:

Westridge Business Park
123 Westridge Drive
Watsonville, California 95076 USA

Telephone:

(408) 377-0500 Voice
(408) 309-8069 Direct/Cell